

Information on Procedures before the Office of the designated Contracting party for Madrid Protocol Applicants

November 2017

		EU (EUIPO)
1. When filing an application: Points to be noted when filling MM2 format		
1.1 Applicant (Item 2 of MM2)		
1.1.1	Points to be noted when writing information about an applicant (Item 2(a), (b) and (f) of MM2 or of any equivalent form or equivalent electronic form)	None.
1.2 Claim of priority (Item 6 of MM2)		
1.2.1	Is partial priority allowed, which is a claim of priority based on part of a basic application? (Yes/No)	Yes.
1.2.2	Are multiple priorities allowed, which is a claim of priority based on multiple basic applications? (Yes/No)	Yes.
1.3 Mark (Item 7 to 9 of MM2)		
1.3.1	Category of marks which can be registered (e.g. collective mark, certification mark, guarantee mark)	The registration of collective marks and certification marks are foreseen by the EUTM Regulation (EUTMR).
1.3.2	Are there certificates required according to category specified in Item 1.3.1? (Yes/No) If a	Yes, for collective and certification marks, the holder shall submit Regulations governing use of the mark directly to EUIPO within a period of two months from notification of the designation by the International Bureau (IB) (Article 75 EUTMR, Article 84 EUTMR and Article 76 EUTMDR.

	required certificate exists, time and method of submission	
1.3.3	Types of non-traditional trademarks that are eligible for registration (three-dimensional, sound, single colour, position, trade dress, etc) and their requirements.	<p>According to Article 4 EUTMR a EU trade mark may consist of any signs, provided that such signs are capable of</p> <ol style="list-style-type: none"> a) distinguishing the goods or services of one undertaking from those of other undertakings and b) being represented on the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded. <p>According to Article 3 EUTMIR the trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner.</p> <p>As well as the traditional types of marks (i.e. word and figurative marks), the non-traditional trade mark types foreseen in the EUTMIR which comply with WIPO's requirement for a graphical representation are the following:</p> <ol style="list-style-type: none"> 1.) Shape mark (representation: graphic or photographic reproduction of the shape, 2.) Position mark (representation: reproduction which approximately identifies the position of the mark and its size or proportion with respect to the relevant goods), 3.) Pattern mark (representation: reproduction showing the pattern of repetition), 4.) Colour mark (representation single colour mark: reproduction of colour and reference to a generally recognized colour code; representation of a combination of colours: reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and reference to a generally recognized colour code) 5.) Sound mark (representation: musical notation), 6.) Motion mark (representation: a series of sequential still images), 7.) Hologram mark (representation: graphic or photographic reproduction), <p>However, other trade mark types are not excluded, as long as they comply with the above mentioned standard of representation.</p>
1.3.4	Is description of a mark required? (Yes/No) If yes, examples of such a description	No.

1.3.5	What an applicant should do if he/she is required to provide a description of his/her mark in question, but such a description cannot be specified in a MM2 format?	Descriptions not appearing in the International Register cannot be added before EUIPO, as EUIPO does not administer a shadow register for International trade marks.
1.3.6	Is there a standard character system? (Yes/No) If yes, what characters belong to the system? (Item 7(c) of MM2)	Yes, Latin, Cyrillic and Greek characters.
1.3.7	Points to be noted for Item 8 of MM2 (COLOR CLAIMED)	None.
1.3.8	Points to be noted for Item 9 of MM2 (MISCELLANEOUS INDICATIONS)	9 d) and e) must be filled in, when applicable.
1.4 Description of the goods and services (Item 10 of MM2)		
1.4.1	Points to be noted for describing designated goods and services	EUIPO does not accept vague terms in the list of goods & services (see Classification guidelines) https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-B/03-part_b_examination_section_3_classification/part_b_examination_section_3_classification_en.pdf
1.4.2	A link to a website to verify whether indications of goods and services are acceptable to an Office	http://tmclass.tmdn.org/ec2/?lang=en
1.5 Declaration of intention to use marks		
1.5.1	Is a declaration of intention to use a mark in question required? (Yes/No) If required, how to submit such a declaration	No.

1.6 Additional features		
1.6.1	(If any [ex. Seniority])	The applicant may, when designating the EU in an international application or as a subsequent designation, claim the seniority of an earlier mark registered in an EU Member State. Such a claim must be presented by attaching form MM17 to the international application or subsequent designation request. No certificates or documents in support of the seniority claims should be attached. Alternatively, the IR holder may also claim the seniority of an earlier mark registered in an EU Member State directly before EUIPO upon publication of the final acceptance of the IR in the EUTM Bulletin.
2. Procedures after a notification of the territorial extension is received at an Office of a Contracting Party		
2.1 Gazettes published by an Office		
2.1.1	Are gazettes published by an Office? (Yes/No)	Yes, the EUTM Bulletin.
2.1.2	If yes, what are included in gazettes?	Please see link to the “Vademecum” to the EUTM Bulletin at the following link: http://euipo.europa.eu/pdf/mark/vademecum-ctm-en.pdf
2.1.3	If yes, is there a link to a website?	https://euipo.europa.eu/eSearch/#advanced/bulletins (under ‘advanced search’ option, ‘Daily publication’).
2.2 Substantive examination		
2.2.1	Does an Office conduct substantive examination? (Yes/No)	Yes.
2.2.2	If substantive examination is conducted, will there be an <i>ex officio</i> examination under i) absolute and ii) relative grounds for refusal be examined by <i>ex officio</i> ?	<i>Ex officio</i> examination is only conducted on absolute grounds during the registration procedure.
2.2.3	Does an Office issue partial refusals?	Yes.
2.2.4	Information on examination standards (a link to a website)	The different sections of the current trade mark practice on Absolute Grounds for refusal, EU collective marks and EU certification marks can be found online at https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines , in Section 4, Chapter 1-16.
2.3 Opposition		
2.3.1	i) A starting date and ii) a period to file an opposition	Oppositions may be filed against the IR between the first month and the fourth month following the date of first republication in the EUTM Bulletin.

2.3.2	Who can raise an opposition?	The proprietor of an earlier trade mark or its authorized licensee, and proprietors of earlier signs or rights pursuant to Article 8(4) and (6) EUTMR, and persons authorized under national law or EU legislation.
2.3.3	Can an opposition be filed before or after a statement of grant of protection is sent? Such a statement is based on Rule 18ter of the Common Regulations.	An opposition must be filed before the statement of grant of protection. After the issuance of the Statement of Grant of protection, only the invalidation of the effects of the IR is available based on an invalidity action or a counterclaim in infringement proceedings (Articles 60 and 201 EUTMR).
2.4 Third party observations/ Information submission system		
2.4.1	Is there third party observations/ information submission system?	Yes.
2.4.2	If yes, i) A starting date and ii) a period to submit observations/ Information?	Until the end of the opposition period and, if an opposition has been filed, as long as the opposition proceedings are open, but not beyond the 18-month time limit for notifying refusals to the IB.
2.4.3	If yes, Person who can submit observations/information?	Any natural or legal person (Article 45 EUTMR).
2.5 Notification of provisional refusal		
2.5.1	Languages used to notify a provisional refusal	The language of filing the International application notified by the IB will be used by EUIPO for issuing provisional refusals. It can be English, French or Spanish.
2.5.2	A period between a day when a notification of territorial extension was sent to an Office and a day when a notification of a provisional refusal is sent (12/18 months)	18 months.
2.5.3	Is there a declaration made in accordance with Article 5(2)(c) of the Madrid Protocol? (Yes/No) Note: Notification of that	No.

	such a provisional refusal may be notified based on opposition after the lapse of period of 18-month	
2.5.4	An average processing time between a day when territorial extension is notified and a day when a First Office Action is made	15 days.
2.5.5	(i) A starting date, ii) a period and iii) an ending day of a time limit to respond to a notification of a provisional refusal. Note: Examples of “i) a day on which the computation begins” are a day when an Office sent a notification of a provisional refusal; a day when the International Bureau sent a notification of a provisional refusal; and a day when a holder received a notification of a provisional refusal. Note: Examples of “iii) an ending day” are a day when a holder sent his/her response; and a day when an Office received a response.	i) The time limit starts on the day on which EUIPO issues the provisional refusal (Article 193(2) to (4) EUTMR). ii) Two months. iii) Two months starting on the day following the notification of the provisional refusal letter. The time limit shall expire on the day of the relevant month having the same number. Where the time limit expires at the end of a month and where the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month (Article 67 EUTMDR). Any time limit will be deemed to expire at midnight on the final day, local time in Alicante (Spain).
2.5.6	Is it possible to extend a time limit to respond to a notification of a provisional refusal? (Yes/No) If yes, how long such a time limit can be	Yes, in principle for another two months. Under certain circumstances further extensions could be granted. The request must be made in writing before the expiry of the time limit. For more information see paragraph 4 of the Guidelines, Part A, General Rules, Section 1: Means of Communication and Time Limits: https://euipo.europa.eu/tunnel-

	extended, and how can such an extension be requested?	web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-A/01-part_a_general_rules_section%201_means_of_communication_time_limits/part_a_general_rules_section%201_means_of_communication_time_limits_en.pdf
2.5.7	Is it always necessary to arrange a local representative when responding to a notification of a provisional refusal? (Yes/No)	Yes, if the IR holder is located outside the territory of the EEA.
2.5.8	Can a holder directly submit his/her response to an Office when responding to a notification of a provisional refusal? (Yes/No)	Yes, if he is located in the territory of the EEA.
2.5.9	Can submitting a MM6 form to request a limitation be regarded as a domestic procedure for amendment? (Yes/No)	The IR holder should forward a copy of the MM6 that he has transmitted to the IB within the time limit for replying to the provisional refusal.
2.5.10	If a MM6 submission is regarded as a response to a provisional refusal, are there any points to be noted such as a time limit for submission? (For example, such points may include that a MM6 form must be filled and submitted to the IB within a time limit to respond to a notification of a provisional refusal, or that	Upon receipt of the copy of the MM6, the file will be put on hold until the limitation is recorded by the IB and notified to EUIPO.

	a notification of a limitation must be sent from the IB to an Office within a time limit of response.)	
2.6 Trial/Appeal against examiner's decision of refusal		
2.6.1	When can demand for an appeal against examiner's decision of refusal be made?	Within two months from notification of the refusal decision.
2.6.2	What is the competent authority for such appeal?	Boards of Appeal of the EUIPO.
2.6.3	Information on appeal against examiner's decision of refusal (a link to a website)	https://euipo.europa.eu/ohimportal/en/appeal
3. Procedures after confirmation of grant of protection in designated contracting parties		
3.1 Registration		
3.1.1	Other than a statement of grant of protection which is a notification based on Rule 18ter of the Common Regulations, is any notification of a decision of registration sent based on domestic laws? (Yes/No) If yes, to whom (a holder/an IB representative) will it be sent?	No.
3.1.2	i) Is a registration certificate automatically issued? (Yes/No) If yes, to whom (a holder/ an IB representative) will it be sent?	i) No. ii) No.

	ii) If a certificate is not issued automatically, is it possible to make a request so that a certificate will be issued? (Yes/No) If yes, how will it be requested?	
3.1.3	Points to be noted for registration (For example, payment of fee)	None.
3.1.4	Points to be noted for the purpose of maintaining the registration such as submitting a affidavits of continued use in commerce	The IR holder has to genuinely use the mark within a period of five years following acceptance of the mark.
3.2 Replacement		
3.2.1	Does an Office require a request to operate procedure for 'taking note' of an international registration?	Yes.
3.2.2	Timing when a request to operate procedure for 'taking note' of an international registration is allowed (while an application being processed, post-registration, etc.)	At any time after notification of the EU designation by the IB.
3.2.3	Does it cost to "take note"?	No, it is free of charge.
3.2.4	When will it be decided to replace a registration in question?	The replacement is entered into the EUTM Register and published in the EUTM Bulletin. In parallel, the IB will be informed and will publish it in the Gazette.
3.2.5	Can a replaced national	Yes.

	registration and an international registration coexist?	
4. Others		
4.1 Trial/Appeal for invalidation		
4.1.1	Time period for filing an invalidation	An application for invalidity may be filed at any time once the Grant of Protection has been issued.
4.1.2	Person who can demand a trial/appeal for invalidation	An invalidity action based on absolute grounds for refusal may be initiated by any natural or legal person. An invalidity action based on relative grounds for refusal may be initiated by the right holder or licensee or as determined by the applicable national law. An invalidity action may also be invoked as a counterclaim in an infringement procedure.
4.1.3	What is the competent authority for such trial/appeal?	The invalidity may be requested directly before EUIPO. In case of an invalidity request made as a counterclaim in an infringement procedure, the EUTM Court which deals with the infringement proceeding will be the competent authority.
4.1.4	Procedure relating to a trial/appeal for invalidation (a link to a website)	Once admissible, the adversarial stage of the proceedings begins which consists of the exchange of observations between the parties. After the end of the proceedings the Cancellation Division issues the First instance decision which may be appealed before the Board of Appeal. For more detailed information on the Cancellation process (invalidity) please see the Guidelines 'Part D': Section 1: Cancellation Proceedings https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-D/01-part_d_cancellation_section_1_proceedings/part_d_cancellation_section_1_proceedings_en.pdf Section 2: Substantive Provisions https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/02-part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf
4.2 Trial/Appeal for cancellation of registered trademark not in use		
4.2.1	Time period for filing a non-use cancellation	An application for revocation based on non-use may be filed not earlier than five years after publication of the acceptance of the IR.
4.2.2	Person who can demand a trial/appeal for	Any natural/legal person.

	cancellation of registered trademark not in use	
4.2.3	What is the competent authority for such trial/appeal?	EUIPO, or in case of a revocation made as a counterclaim in an infringement procedure, the EUTM Court which deals with the infringement proceedings will be the competent authority.
4.2.4	Procedure relating to a trial/appeal for cancellation of registered trademark not in use (a link to a website)	<p>Once admissible, the adversarial part of the proceedings begins, which consists of the exchange of observations between the parties. After the end of the adversarial part of the proceedings the Cancellation Division issues a decision which may be appealed before the Board of Appeal.</p> <p>For more detailed information on the Cancellation process (revocation) please see the Guidelines 'Part D':</p> <p>Section 1: Cancellation Proceedings https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/01-part_d_cancellation_section_1_proceedings/part_d_cancellation_section_1_proceedings_en.pdf</p> <p>Section 2: Substantive Provisions https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-D/02-part_d_cancellation_section_2_substantive_provisions/part_d%20cancellation_section_2_substantive_provisions_en.pdf</p>
4.3 Trial/Appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee		
4.3.1	Time period for filing an unfair use cancellation	An application for revocation may be filed, if as a result of use made of the mark by the proprietor or with its consent, the mark is liable to mislead the public, particularly concerning the nature, quality or geographical origin of the goods or services for which it is registered.
4.3.2	Person who can demand a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	Any natural/legal person.
4.3.3	What is the competent authority for such trial/appeal?	EUIPO, or in case of a counterclaim in an infringement procedure, the EUTM Court which deals with the infringement proceedings will be the competent authority.
4.3.4	Procedure relating to a trial/appeal for	The adversarial part of the procedure begins with the valid request, followed by the exchange of observations between the parties. After closure of the adversarial part the Cancellation Division issues a decision, which may be appealed before the Board of Appeal.

	cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	
4.4 Other information relating to a trial/appeal		
4.4.1	Other information relating to a trial/appeal	
4.5 Invalidation of the effects of an international registration in part or in whole		
4.5.1	Where the effects of an international registration in a designated Contracting Party are cancelled in part or in whole because of a trial/appeal for invalidation etc, the timing when a notification of invalidation per Rule 19 of the Common Regulations will be sent to the International Bureau	As soon as the decision is final.
4.6 Transformation of an international registration into national or regional applications under Article 9quinquies of Madrid Protocol		
4.6.1	Points to be noted for transformation (If any) An amount of a fee if such a fee needs to be paid	<p>Following the cancellation in whole or in part of an IR designating the EU at the request of the office of origin under Article 9quinquies Madrid Protocol, the holder may file a 'direct' EUTM application for the same mark and the same goods and services as the cancelled mark.</p> <p>This transformation may be filed within three months from the recordal by the IB of the cancellation at the request of the Office of origin. The fee is the usual filing fee applicable for a new EUTM application.</p> <p>If the EU designation under the cancelled IR had already been accepted by EUIPO when the cancellation takes effect, the new EUTM resulting from the transformation will not be re-examined again, nor will it be published for opposition purposes.</p> <p>The date of the original EU designation will not become the filing date of the new EUTM application, however it will be the date that determines the 'earlier right effect' of the EUTM for the purposes of inter partes proceedings (oppositions, cancellations), etc.</p>
4.7 Additional features		
4.7.1	(If any [ex. Conversion])	The option of conversion allows an EU designation through an IR to be converted into a national trade mark application, just like

		for a direct EUTM. Regarding certification marks, a conversion is however only possible into Member States providing for guarantee or certification marks. Where the EU designation has been refused or ceases to have effect, it may be converted into national trademark applications in the EU Member States or designations of Member States party to the Madrid Protocol enjoying the date of designation of the EU or the date of priority, if any (Article 202 EUTMR).
5. Madrid Protocol declarations		
5.1	Article 5(2)(b) of the Protocol (extension to 18 months of the refusal period)(Yes/No)	Yes
5.2	Article 5(2)(c) of the Protocol (possible notification of refusals based on an opposition after the 18-month time limit)(Yes/No)	No
5.3	Article 8(7)(a) of the Protocol (individual fees)(Yes/No)	Yes
5.4	Article 9 <i>quater</i> of the Agreement and that of the Protocol (Common Office of several Contracting States)(Yes/No)	No
5.5	Article 14(2)(d) of the Agreement (in respect of international registrations effected under the Agreement prior to the date of accession of the Contracting Party concerned, no subsequent designation)(Yes/No)	No
5.6	Article 14(5) of the Protocol (in respect of international registrations effected under the	No

	Protocol prior to the date of accession of the Contracting Party concerned, no subsequent designation)(Yes/No)	
5.7	Rule 7(2) of the Common Regulations (declaration of intention to use the mark)(Yes/No)	No
5.8	Rule 17(5)(d) of the Common Regulations (notwithstanding the fact that all procedures before the Office may not have been completed, notification to the International Bureau by the Office of decisions concerning refusals)(Yes/No)	No
5.9	Rule 17(5)(e) of the Common Regulations (<i>ex officio</i> provisional refusals not open to review before the Office)(Yes/No)	No
5.10	Rule 20 <i>bis</i> (6)(a) of the Common Regulations (recording of licenses not provided for in the domestic law, so that the recording of licenses in the International Register has no effect)(Yes/No)	No
5.11	Rule 20 <i>bis</i> (6)(b) of the Common Regulations (recording of licenses provided for in the	No

	domestic law, but the recording of licenses in the International Register has no effect)(Yes/No)	
5.12	Rule 34(2)(b) of the Common Regulations (the Office accepts to collect and forward fees to the International Bureau)(Yes/No)	No
5.13	Rule 34(3)(a) of the Common Regulations (individual fee payable in two parts)(Yes/No)	No